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First Named Inventor	Barber, Timothy P.
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ENCLOSURES *(Check all that apply)*

- ☐ Fee Transmittal Form
- ☐ Fee Attached
- ☐ Amendment/Reply
- ☐ After Final
- ☐ Affidavits/declaration(s)
- ☐ Extension of Time Request
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- ☐ Information Disclosure Statement
- ☐ Certified Copy of Priority Document(s)
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Remarks

3 copies of Supplemental Brief for Appellants
3 copies of Amendment to Accompany Supplemental Appeal Brief

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name	James A. Retter - Ware, Fressola, Van Der Sluys & Adolphson LLP
Signature	
Date	March 1, 2004

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

First named inventor: Barber, Timothy P.

Serial No.: 09/741,207

Filed: Dec. 19, 2000

Title: Method for Secure, Closed Loop Money Transfer via Electronic Mail

Group Art Unit: 3624

Examiner: Akers, Geoffrey R.

MAIL STOP APPEAL BRIEFS--PATENTS
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SUPPLEMENTAL BRIEF FOR APPELLANTS

Sir:

This is a supplemental appeal brief in response to an Office action mailed Dec. 1, 2003, reopening prosecution. This supplemental appeal brief follows an initial appeal from an Office action mailed June 18, 2003, made final, in response to which a Notice of Appeal was filed on Aug. 15, 2003. The brief for the initial appeal was then mailed on Sept. 3, 2003. Upon review of the initial appeal brief, prosecution was reopened and a new Office action was issued. Applicant requests reinstatement of the appeal per 37 CFR 1.193(b)(2). This paper provides the supplemental appeal brief required by 37 CFR 1.193(b)(2) when reinstating an appeal, and is being filed within the three-month period for response to the Office action mailed Dec. 1, 2003.

Table of Contents

I. THE REAL PARTY IN INTEREST

The real party in interest continues to be Timothy P. Barber, the party named in the caption of the brief.

II. RELATED APPEALS AND INTERFERENCES

There are no related appeals and interferences, aside from the appeal mailed on Sept. 3, 2003, to which this appeal brief is a supplement.

III. STATUS OF CLAIMS

Claims 1-8 are pending, and as of the Office action mailed Dec. 1, 2003, continue to stand rejected, and are still being appealed.

IV. STATUS OF AMENDMENTS

With this supplemental appeal, a paper is also filed that requests entry of an amendment that would correct an obvious typographical error (of omission) in claim 1. The application would still include claims 1-8.

V. SUMMARY OF THE INVENTION

Applicant hereby incorporates into this supplemental appeal-brief the summary of the invention section of the initial appeal brief, mailed Sept. 3, 2003.

VI. ISSUE

The following issue will be addressed in the argument:

Whether the Office action (mailed Dec. 1, 2003) erred in rejecting claims 1-8 under 35 USC section 103 as unpatentable over Mitty *et al.* (U.S. Pat. No. 6,145,079) in view of Tycksen,

Jr. *et al.* (U.S. Pat. No. 6,189,097) and further in view of Boesch *et al.* (U.S. Pat. No. 5,870,473).

VII. GROUPING OF THE CLAIMS

With respect to the rejection of under 35 USC section 103, all claims are involved, namely claims 1-8, and (only) the rejection of claim 1 is argued, and claims 2-8 are to stand or fall with claim 1.

VIII. ARGUMENT

B. Error in rejection of claim 1 under 35 USC section 103

At paragraph 5 of the Office action (mailed Dec. 1, 2003), claims 1-8 are rejected under 35 USC §103(a) as being unpatentable over Mitty *et al.* (U.S. Pat. No. 6,145,079) in view of Tycksen, Jr. *et al.* (U.S. Pat. No. 6,189,097) and further in view of Boesch *et al.* (U.S. Pat. No. 5,870,473).

The invention as claimed in claim 1 is easily distinguished over the teachings and suggestions of the references as applied in the Office action. The invention as claimed in claim 1 provides for transferring money over a computer network (such as the Internet) based on attaching to an e-mail a document--called a stamp in the application--bearing a data item that is a concatenation of several fields, including an encrypted field, and having both a face value (the amount of the stamp) and a lifespan (indicating the latest time and date on which the stamp can be redeemed for the face value) indicated on the stamp/ document (i.e. so that a person receiving the e-mail can immediately see the face value and the lifespan). As claimed in claim 1, a receiver of an e-mail including (as an attachment or in an attachment) such a stamp then redeems the stamp by presenting the stamp to a predetermined entity (possibly doing so over the same telecommunication system by which the e-mail

bearing the stamp was communicated to the receiver). (The end result is the transfer of money, but a particularly useful result is that an advertiser can entice a person receiving an advertisement by e-mail to open the e-mail by in effect offering to pay the person for doing so, using a stamp according to the invention.)

Although the examiner asserts at paragraph 6, that Mitty teaches "a sender sending a stamp having a face value and affixed to an e-mail," citing the Abstract and Fig. 6, item 635, in fact at the cited locations, Mitty teaches and suggests only the use of "a novel data arrangement" that in effect allows receiving confirmation of receipt of a message including important documents, and (more or less) guaranteeing that the important documents arrive unchanged and unread (by an eavesdropper). There is absolutely no teaching of a face value or a lifespan indicated on the novel data arrangement (i.e. what the Examiner likens to a stamp according to the invention). The "valued content" 635 enclosee in the (encrypted) envelope data 625 is first of all, not a value in the sense used in the application (i.e. having worth in terms of money), but is instead the valuable documents being delivered, as explained at col. 17, ll. 16-23, which reads:

> The valued contents 635 is application specific. In the examples above, this included the text message that the sender 105 desired to send.

Second, the "valued content" 635 is obviously not indicated "on" the novel data arrangement (so as to be viewable by the person receiving the stamp so that the person can decide whether it is worthwhile to further examiner the novel data arrangement, i.e. read the e-mail), since one of the principal objectives of the novel data arrangement--as explained at col. 2, line 2--is to provide privacy.

After erroneously asserting at paragraph 6 that Mitty teaches "a sender sending a stamp have a face value and affixed to an email," the Examiner then asserts that Mitty teaches "a

sender ... and a recipient ... and a network ... and even a trusted intermediary ..." (and applicant is willing to concede that the existence of such entities is prior art), and the Examiner then makes a series of assertions applicant's attorney believes to be irrelevant to the issue at hand (or indeed, that appear to be irrelevant to deciding on patentability of any of the claims of the application). For example, the Examiner asserts that "Mitty further teaches creating and initializing an electronic waybill data structure ... ." None of the claims of the application recite creating and initializing an electronic waybill data structure. The same can be said for the other further teachings of Mitty called out in the Office action.

At about line 6 of page 3 of the Office action, the Examiner then supplements his assertions of the alleged teaching of Mitty by asserting that "Tycksen teaches an issue time (Fig. 1/11a) and a certificate number (Fig. 1/11a) and a lifespan (Fig. 1/11p) with application to the Internet (col 4 lines 36-58)." What Tycksen teaches is what has come to be known as digital certificates, and applicant concedes the existence of digital certificates, but respectfully submits that Tycksen nowhere teaches or suggests any of the elements of the invention as claimed in claim 1. Claim 1 does not recite "an issue time" or "a certificate number." Further, the "lifespan" indicated in Fig. 1/11p is actually a "license expiration component" in respect to a DSLC (digitally signed license certificate) 10, issued as proof of ownership (until the license expiration) of a digital product; the "license expiration component" in no way serves as a lifespan of a stamp according to the invention (i.e. indicating the due date and possibly the time by which the stamp can be redeemed for its face value). The Examiner then goes on to note other alleged teachings of Tycksen (e.g. license terms), but nowhere explains what the alleged teachings have to do with any of the steps or other limitations recited in any of the claims of the

application, and he also indicates that Tycksen teaches "nuts and bolts" of the invention (such as "e-mail" and "hash," both of which applicant concedes are prior art), but does not assert or explain how such "nuts and bolts" relate to the application as claimed. Finally, at about line 16 of page 3 of the Office action, the Examiner further supplements his assertions by alleging that Boesch teaches "a method for providing for money transfer over a network," citing the Abstract and col. 2, line 21 to col. 3, line 5, "as well as a face value (Fig 4C/120G.2)." In contrast to the invention, Boesch teaches a method by which a customer can buy goods and services from a merchant over a communication network such as the Internet, a method that is supposedly secure but with a "reduc[ed] level of encryption" (as explained at col. 1, ll. 13-17). In regard to the assertion by the Examiner that Boesch discloses "providing for money transfer over a network ... as well as a face value ...," applicant respectfully again points out that the face value recited in claim 1 is the value for which a stamp (according to the invention) may be redeemed, whereas 120G.2 of Fig. 4C is a field of a "persona" data base 201, not a field of a stamp/data object being attached to an e-mail, and indicates not a redemption value of a stamp, but instead an "available balance" of a "cash container" (used to hold funds for transfer to and from "an (financial) instrument," such as a credit card, a debit card, or a demand deposit account, per the description of field 254A. (Although nowhere explained in Boesch, a cash container is apparently one or another kind of account holding money for use in paying for goods or services, via one or another kind of financial instrument. For example, a cash container could apparently be a checking account at a bank.) Thus, contrary to the assertion made in the Office action, Boesch does not teach providing a stamp having a face value. Moreover, claim 1 makes clear that the step of "providing a stamp" is a step in which a stamp issuer sends to a sender a stamp (having a face value), and

Boesch nowhere teaches such a step. As the Examiner did for Tycksen, he then goes on to note other alleged teachings of Boesch (e.g. a "transaction payment process"), but nowhere explains what the alleged teachings have to do with any of the steps or other limitations recited in any of the claims of the application, and he also indicates that Boesch also teaches some "nuts and bolts" of the invention (such as "e-mail addresses," which applicant concedes is prior art), but does not assert or explain how such "nuts and bolts" relate to the application as claimed.

For the foregoing reasons, applicant respectfully insists that the rejection under 35 USC §103 of claim 1 is error.

D. COROLLARIES OF THE PRECEDING ARGUMENTS

It has been argued above that there was error in rejecting claims 1 under 35 USC §103. Accordingly, and as set out in the above grouping of the claims, it is here asserted that there was error in the rejections under 35 USC §103 of all the other claims remaining in the application, namely claims 2-8, since all of the other claims depend from claim 1, and stand (or fall) with claim 1.

IX. CONCLUSION

For all of the aforementioned reasons, it is respectfully submitted the rejections of all the claims in the application, namely claims 1-8, are error, and the rejections should be reversed. Early allowance of all the claims in the application is earnestly solicited.

Respectfully submitted,

March 1, 2004
Date

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X. APPENDIX--THE CLAIMS INVOLVED IN THE APPEAL

A. CLAIMS AFTER ENTRY OF THE AMENDMENT ACCOMPANYING THE PRESENT BRIEF

1. (Currently amended) A method of providing for a money transfer over a network, comprising steps in which:

a) a stamp issuer provides to a sender a stamp having a face value and a lifespan both indicated on the stamp, the stamp being a string that is a concatenation of two or more fields including the face value and the lifespan, with at least one of the fields calculated according to a prescription involving a hashing or encryption of a concatenation of others of the fields or of some other field not part of the stamp;

b) the sender affixes the stamp to an e-mail and sends the e-mail to a recipient; and

c) the recipient of the e-mail redeems the stamp for the face value by presenting the stamp to a predetermined entity;

wherein the predetermined entity provides the face value to the recipient only if the stamp is presented to the predetermined entity within the lifespan indicated on the stamp.

2. (Original) A method as in claim 1, wherein the stamp is a concatenation of a set of fields, the set comprising:

a) an issue time;

b) a lifespan;

c) a stamp value; and

d) a first-hashed field that is a hash of a concatenation of all of the preceding fields and, in addition a secret constant known only to the stamp issuer.

3. (Original) A method as in claim 2, wherein the first-hashed field is a predetermined truncation of the output of the hash of the concatenation of all of the preceding fields and, in addition a secret constant known only to the stamp issuer.

4. (Original) A method as in claim 2, wherein the set of fields of which the stamp is a concatenation further comprises a second-hashed field that is a hash of the issue time field, the lifespan field, the stamp value field, and the first-hashed field.

5. (Original) A method as in claim 4, wherein the second-hashed field is a predetermined truncation of the output of the hash of the issue time field, the lifespan field, the stamp value field, and the first-hashed field.

6. (Original) A method as in claim 4, wherein the set of fields of which the stamp is a concatenation further comprises a digital signature field that is a digitally signed encryption of the issue time field, the first-hashed field and the second-hashed field, wherein the encryption is performed using a private key of the stamp issuer.

7. (Original) A method as in claim 4, wherein the set of fields of which the stamp is a concatenation further comprises a digital signature field that is a pre-determined truncation of the issue time field, the first-hashed field, the second-hashed field, and a secret constant, known only to the stamp issuer and other qualified parties.

8. (Original--added by amendment) A method as in claim 1, wherein the predetermined entity is the stamp issuer.

B. CLAIMS BEFORE ENTRY OF THE AMENDMENT ACCOMPANYING THE PRESENT BRIEF

1. (Previously amended) A method of providing for a money transfer over a network, comprising steps in which:

a) a stamp issuer provides to a sender a stamp having a face value and a lifespan both indicated on the stamp, the stamp being a string that is a concatenation of two or more fields including the face value and the lifespan, with at least one of the fields calculated according to a prescription involving a hashing or encryption of a concatenation of others of the fields or of some other field not part of the stamp;

b) the sender affixes the stamp to an e-mail and sends the e-mail to a recipient; and

c) the recipient of the e-mail redeems the stamp for the face value by presenting the stamp to a predetermined entity;

wherein the predetermined entity provides the face value to the recipient only if the stamp is presented the predetermined entity within the lifespan indicated on the stamp.

2. (Original) A method as in claim 1, wherein the stamp is a concatenation of a set of fields, the set comprising:

a) an issue time;

b) a lifespan;

c) a stamp value; and

d) a first-hashed field that is a hash of a concatenation of all of the preceding fields and, in addition a secret constant known only to the stamp issuer.

3. (Original) A method as in claim 2, wherein the first-hashed field is a predetermined truncation of the output of the hash of

the concatenation of all of the preceding fields and, in addition a secret constant known only to the stamp issuer.

4. (Original) A method as in claim 2, wherein the set of fields of which the stamp is a concatenation further comprises a second-hashed field that is a hash of the issue time field, the lifespan field, the stamp value field, and the first-hashed field.

5. (Original) A method as in claim 4, wherein the second-hashed field is a predetermined truncation of the output of the hash of the issue time field, the lifespan field, the stamp value field, and the first-hashed field.

6. (Original) A method as in claim 4, wherein the set of fields of which the stamp is a concatenation further comprises a digital signature field that is a digitally signed encryption of the issue time field, the first-hashed field and the second-hashed field, wherein the encryption is performed using a private key of the stamp issuer.

7. (Original) A method as in claim 4, wherein the set of fields of which the stamp is a concatenation further comprises a digital signature field that is a pre-determined truncation of the issue time field, the first-hashed field, the second-hashed field, and a secret constant, known only to the stamp issuer and other qualified parties.

8. (Original--added by amendment) A method as in claim 1, wherein the predetermined entity is the stamp issuer.